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| 09/975,903      | 10/12/2001  | Thomas J. Murray     | 79069ADAN           | 2305             |

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EXAMINER

BRINICH, STEPHEN M

| ART UNIT | PAPER NUMBER |
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2624

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/975,903

Applicant(s)

MURRAY ET AL.

Examiner

Stephen M. Brinich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9, 10, 13-26 and 30-34 is/are rejected.
- 7) ☒ Claim(s) 4-8, 11, 12 and 27-29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ✓ 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ✓ 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/12/01, 1/21/03.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 32-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 32-33 are drawn to non-functional descriptive material.

MPEP 2106.IV.B.1(a) (Nonfunctional Descriptive Material) states:

Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101.

Where certain types of descriptive material, such as music, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing process performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer.

For example, music is commonly sold to consumers in the form of a compact disc. In such cases, the know compact disc acts as nothing more than a carrier for nonfunctional descriptive material. The purely nonfunctional descriptive

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material cannot alone provide the practical application for the manufacture.

MPEP 2106.IV.B.1 (Nonstatutory Subject Matter) states:

When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement.

Claims 32-33 currently recite(s) a pair of images on a print. There is no functional relationship imparted by this data to a computing device. Therefore, the claim is drawn to non-functional descriptive material which is non-statutory per se. The fact that the claim recites a computer readable medium does not provide the utility (i.e., practical application in the technological arts) required under 35 U.S.C. 101 for the manufacture.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and

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distinctly claim the subject matter which applicant regards as the invention.

The recitation (claim 12, line 5) of "other objectionable image artifacts" as one of the reasons why an image would be disqualified for enhancement renders the scope of the recited disqualification operation vague.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 9-10, 13-26, & 30-34, insofar as claims 32-33 are understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sano in view of Adachi et al (EP 0890870).

Re claims 1-2, 13, 16-17, 23, 25, 30-32, & 34, Sano discloses (column 2, lines 2-40) an image printing system in which a plurality of optical images are subject to pre-print digital enhancement, with an amount of enhancement determined for each individual image so as to produce the highest quality rating for the image enhancement algorithm used.

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Sano does not describe the printing of a given image both with and without enhancement. Adachi et al (Abstract; page 3, line 35 - page 4, line 1) discloses a system for printing a plurality of versions of a given image, including one standard image and at least one processed image, in order to allow an end user to view the different final appearances.

Sano and Adachi et al are combinable because they are from the field of image enhancement and enhanced image production.

The printing and display of processed and non-processed images in Sano would be an expedient obvious to one of ordinary skill in the art. The motivation for doing so would be to allow a user evaluation of the Sano enhancement, similar to the user evaluation described by Adachi et al.

Therefore, it would have been obvious to combine Sano with Adachi et al to obtain the invention as specified in claims 1-2, 13, 16, 23, 25, 30-32, & 34.

Re claim 33, Adachi et al does not disclose the generation of a message for the consumer. The use of text to label images would be an expedient of obvious skill in the art. The motivation for such labeling would be distinguish two similar images (such as, in the case of the present art, the same image with and without a given processing) would be an expedient obvious to one of ordinary skill in the art.

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Therefore, it would have been obvious to combine Sano with Adachi et al to obtain the invention as specified in claims 8 & 33.

Re claim 9, Adachi et al further disclose (page 17, lines 42-44) that the images are obtained optically, and that one has been subjected to improvement.

Re claim 14 & 17, Adachi et al further discloses (Figure 5; page 17, lines 33-44) side-by-side printing of the two images in a line.

Re claims 3, 10, 15, 18-19, & 22, Adachi et al further discloses (Figure 1; page 4, lines 27-28) the use of two separate photo printers (printer 60 and a "DIFFERENT DIGITAL PHOTO PRINTER SYSTEM" connected via communication port 76), which would inherently produce output on two different sheets.

Re claims 20-21, & 26, Sano in view of Adachi et al does not describe the transmission of the images to a remote display location via a data connection such as the Internet. The use of the Internet to transfer data to a remote location for display is well known to one of ordinary skill in the art. The transmission of the enhanced and unenhanced images described by Sano in view of Adachi et al via such a connection would be an expedient of ordinary skill in the art. The motivation for such an arrangement would be to permit a customer to review these

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images from a convenient location (such as a shopping-mall kiosk or the customer's home).

Therefore, it would have been obvious to combine Sano with Adachi et al to obtain the invention as specified in claims 20-21, & 26.

Re claim 24, Sano in view of Adachi et al describes the generation of a final output in the form of an image print rather than an image placed on a CD. The use of a CD as a medium to store data, such as an image, is well known to one of ordinary skill in the art. The output of the final image output of Sano in view of Adachi et al to a CD would be an expedient of ordinary skill in the art. The motivation for such an arrangement would be generate an output in a more convenient format (e.g. the storage of a large number of images on a single CD rather than a large sheaf of printouts).

Therefore, it would have been obvious to combine Sano with Adachi et al to obtain the invention as specified in claim 24.

***Allowable Subject Matter***

5. Claims 4-8, 11-12, & 27-29, insofar as claim 12 is understood, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



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Re claims 4-6 & 11-12 (and dependent claims 7-8), the art of record does not teach or suggest the recited selection of images for processing based on the described criteria in conjunction with the recited arrangement for generating and printing sets of enhanced and unenhanced images.

Re claim 27 (and dependent claims 28-29), the art of record does not teach or suggest the recited assignment of a value representative of an amount of applied image enhancement in conjunction with the recited arrangement for generating and printing sets of enhanced and unenhanced images.

**Conclusion**

6. Any inquiry concerning the contents of this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430.

Any inquiry relating to the status of this application or proceeding or any inquiry of a general nature concerning application processing should be directed to the Tech Center 2600 Customer Service center at 571-272-2600 or to the USPTO Contact Center at 800-786-9199 or 703-308-4357.


The examiner can normally be reached on weekdays 7:00-4:30, alternate Fridays off.

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If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 571-272-7437.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 571-273-8300 (as of July 15, 2005).

Hand-carried correspondence may be delivered to the Customer Service Window, located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

  
Stephen M Brinich  
Examiner  
Art Unit 2624

smb  
October 14, 2005